

04-14-04

AF/3714



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ERNEST W. MOODY

Appl. No.: 09/894,501

Art Unit: 3714

Filed: June 28, 2001

Examiner: Coburn, C.

For: APPARENT SKILL GAME USED AS A BONUS ROUND ON A GAMING MACHINE

MAIL STOP APPEAL BRIEF -- PATENTS

Commissioner for Patents

P.O. BOX 1450

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TECHNOLOGY CENTER R3700

REQUEST FOR REINSTATEMENT OF APPEAL

Dear Sir:

This is in response to the Office Action dated January 12, 2004.

I hereby certify that this correspondence is being deposited with the United States Postal Service as on this date April 12, 2004 in an envelope as "Express Mail Post Office to Addressee" Mailing Label No. ER155256272US addressed to: MAIL STOP APPEAL BRIEF -- PATENTS, COMMISSIONER FOR PATENTS, PO BOX 1450, ALEXANDRIA, VA 22313-1450.

Ernest W. Moody

Applicant(s)

Signature

April 12, 2004

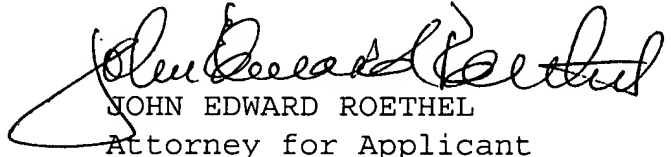
Date of Signature

Appellant respectfully requests that the Appeal in this matter be reinstated.

By Office Action dated January 12, 2004, the Examiner reopened prosecution of this application and entered a new ground of rejection on a recently discovered reference. There is only one claim pending in this application.

Filed herewith is a Supplemental Brief (in triplicate) on behalf of Appellant.

Respectfully submitted,


JOHN EDWARD ROETHEL
Attorney for Applicant
Registration No. 28,372

2290 South Jones Blvd., #100
Las Vegas, Nevada 89146
Phone: (702) 364-1190



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APPELLANT'S SUPPLEMENTAL APPEAL BRIEF

1. REAL PARTY IN INTEREST

This application has not yet been assigned, but it is under contract to be assigned to Action Gaming, Inc., a Nevada corporation.

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Ernest W. Moody
Applicant(s)

Signature

April 12, 2004

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2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF CLAIMS

Claim 1 is pending in this application. Claim 1 stands rejected.

4. STATUS OF AMENDMENTS

There are no Amendments after Final Rejection.

5. SUMMARY OF THE INVENTION

The present invention includes an apparent game of skill or knowledge as a secondary event bonus round game which is won by the player during the play of a conventional electronic or mechanical gaming machine. A gaming machine, such as a slot machine, poker game machine, keno game machine, bingo game machine or other casino game of chance machine is first played by the player and, upon the occurrence of a predetermined outcome of the gaming machine, the player wins an opportunity to play the secondary event bonus round game.

At the commencement of the secondary event bonus round game, the computer controls of the electronic gaming machine first

select the amount of the award to be won by the player during the play of the secondary event game. The player then plays out the secondary event bonus round game, which appears to the player to be a game of skill or knowledge. Regardless of how the player fares during the play of the secondary event bonus round game, the play of the secondary event bonus round game continues until the player has achieved the predetermined amount that was selected by the computer controls. Thus, the player's skill or knowledge level or ability during the play of the secondary event bonus round game has no affect on the amount won by the player during the play of the secondary event bonus round game.

Claim 1 is the only claim and sets out the method of play of the present invention:

Claim 1. A method of playing a gaming machine in which a bonus round includes an apparent game of skill or knowledge comprising:

- a) a player making a wager to play the gaming machine;
- b) activating the gaming machine to cause a game of chance to occur;
- c) determining an outcome of the game of chance;
- d) if the outcome awards the player with the bonus round, selecting an amount of a bonus payout to be paid to the player

during the bonus round; and

e) allowing the player to participate in the apparent game of skill or knowledge at the end of which the player receives the bonus payout.

6. ISSUES

Whether Claim 1 is unpatentable under 35 U.S.C. §102(b) as being anticipated by Hoke (2102532).

7. GROUPING OF CLAIMS

Claim 1 stands as the first and only group of claims.

8. ARGUMENTS

Claim 1 is pending in this application.

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by Hoke (2102532).

Analysis of Hoke reference

Hoke discloses a gaming machine in the form of a coin operated slot machine which apparently was the state-of-the-art in 1937, the date of the Hoke patent.

The bulk of the disclosure in this patent relates to the

mechanical apparatus of the invention. However, Hoke discloses (at column 1, line 3 through column 1, line 26) two of the objects of his invention. In general, the objects of the invention discussed by Hoke relate to a gaming machine that is equipped with an object throwing device, such as a ball, which controls the final operation of the machine before a payout may be had therefrom should an operator win a payout. For example, a snake representation is used -- the operator presses on a trigger 75 (imitating the tail of a snake) that causes a ball 77 to be projected toward the open mouth 68 of the head 67 of the imitation of the snake. See Figure 15.

Beginning at column 4, line 4, Hoke describes how his invention operates. In order for the player to win a payout on Hoke's gaming machine, two things must happen: first, a winning combination on the slot reels must be achieved; and second, the player must project the ball into the mouth of the head of the snake.

Arguments regarding rejection

In order for a rejection based on 35 U.S.C. §102(b) to be proper, each and every step of the claimed invention must be disclosed within the reference used as the basis of the rejection.

Hoke discloses a combination gaming machine that combines a game of random chance (the spinning of the slot reels) with a game of actual skill (projecting the ball into the mouth of the head of the snake). The player must be both lucky and skilled to win a payout.

Claim 1 specifies that a determination of an outcome of the game of chance is first made. And then, if the outcome of the game of chance awards the player a bonus round, the selecting an amount of a bonus payout to be paid to the player during the bonus round.

The Hoke disclosure does not award the player with a bonus round based on an outcome of the game of chance. Hoke determines an award to be paid to the player when certain symbols are lined up during the play of the slot reel game of chance. However, before the player can collect this award, the player must engage in a game of skill (projecting the ball into the mouth of the head of a snake).

Furthermore as set out in Claim 1, after the amount to be won by the player is selected prior to the player participating in the bonus round, then the player participates in an apparent game of skill or knowledge as the bonus round. At the end of the player's participation in this apparent game of skill or knowledge, the

player is awarded the preselected bonus amount regardless of how well or poorly the player performs in the bonus round.

Hoke does not have a bonus round of any kind. A player playing the Hoke slot machine can only win if two things happen: 1) the player receives a combination of slot symbols that result in a winning slot reel payout and 2) the player is successful in the skill portion of the game.

Claimed invention: apparent game of skill.

Hoke disclosure: actual game of skill.

In Hoke, the player can achieve a potentially winning payout on the slot reels, but the player would not receive the winning payout if the player is unsuccessful in the skill portion of the game.

In Claim 1, the player always wins the bonus award.

Examiner's reliance on Geddes

At page 3 of the rejection, the Examiner discusses a paragraph in Geddes, from page 116 of the book *Slot Machines on Parade*, that discusses a game known as the Mills HOKE SNAKE. The Examiner has made this reference "of record but not relied upon for this rejection." Counsel for Appellant has been a registered patent attorney for more than 25 years and before that was an examiner.

Nevertheless, counsel does not understand what the evidentiary effect is of a reference "of record but not relied upon for this rejection."

As the Examiner goes on to explain in the rejection on page 3, in the Examiner's opinion, this paragraph from Geddes "makes it plain that the bonus game (flipping the ball into the snake's mouth) is an illusion of skill game [sic]."

Assuming either the Examiner or the Board of Appeals finds the reference to Geddes to have some evidentiary effect and treats the Examiner's rejection as an obviousness rejection under 35 U.S.C. §103, Appellant submits that nothing in Geddes teaches or suggests the limitation of Claim 1 that the player is allowed "to participate in an **apparent** game of skill or knowledge at the end of which the player receives a bonus payout".

As the Examiner notes, Geddes states that the element of skill in the Mills HOKE SNAKE game was a complete sham. And that the skill required to feed the snake required the ability to steam a mirror using only your breath.

Nevertheless, the Examiner's argument that the Mill HOKE SNAKE game is an **illusion** of a skill game is still different from the recitation of Claim 1 that the player participates in an **apparent** game of skill or knowledge.

While the skill required in Hoke may be nominal at best, a nominal skill is still more skill than no skill at all. A person must learn how to steam a mirror using only his breath and certainly there are people who could not perform this skill. After all, a person has to be a certain distance from the mirror to effect a steaming and a person has to learn how to breathe out onto the mirror's surface to cause the steam to be shown on the mirror.

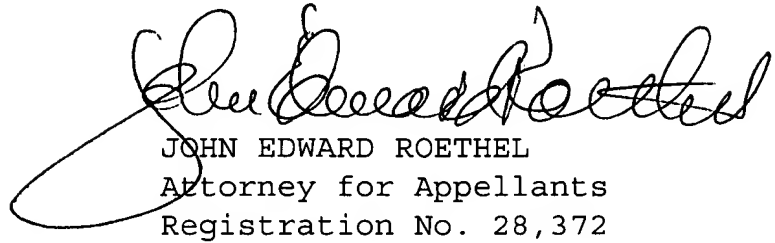
In contrast, absolutely no skill is required in the method of Claim 1. Whether the player steamed the mirror or not, "the player receives the bonus award."

9. CONCLUSION

Appellant submits that Claim 1 has been improperly rejected by the Examiner under 35 U.S.C. 102(b). Appellant respectfully requests that the Board of Appeals reverse the Examiner's rejection of Claim 1 and remand this application to the Examiner for further action consisting of a Notice of Allowance.

An Appendix is attached to this Brief setting out in full the claim on appeal.

Respectfully submitted,



JOHN EDWARD ROETHEL
Attorney for Appellants
Registration No. 28,372

2290 S. Jones Blvd., #100
Las Vegas, NV 89146
Phone: (702) 364-1190

APPENDIX

Claim 1. A method of playing a gaming machine in which a bonus round includes an apparent game of skill or knowledge comprising:

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- d) if the outcome awards the player with the bonus round, selecting an amount of a bonus payout to be paid to the player during the bonus round; and
- e) allowing the player to participate in the apparent game of skill or knowledge at the end of which the player receives the bonus payout.